

REMARKS

This Amendment is submitted in response to the Office Action dated October 21, 2002. In the Office Action, the Patent Office objected to the drawings under 37 CFR §1.83(a) because they allegedly fail to show certain features in Figure 2. The Patent Office rejected Claims 3, 6 and 7 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Further, the Patent Office rejected Claims 1-11 and 13-20 under 35 U.S.C. §103(a) as being unpatentable over *Iliff* (U.S. Patent No. 6,022,315) in view of *Schlueter et al.* (U.S. Patent No. 5,974,124), and Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Iliff* and *Schlueter et al.*, and further in view of *Siegrist, Jr. et al.* (U.S. Patent No. 5,652,842).

By the present Amendment, Applicant amended the specification and Claims 3, 6 and 7. Applicant submits that the amendments overcome the objections and rejections by the Patent Office for the reasons that follow. Notice to that effect is requested.

The Patent Office objected to the drawings under 37 CFR §1.83(a) because they allegedly failed to show specific features in Figure 2. More specifically, the Patent Office stated that Figure 2 did not show databases 18, 20 and remote computers 24, 26 as identified on page 9, lines 4-12 of the specification. Applicant amended the specification to clearly identify that the databases 18, 20 and the remote computers 24, 26 are those shown in Figure 1.

Applicant respectfully submits that the amendment to the specification overcomes the objection. Notice to that effect is requested.

With respect to the rejection of Claims 3, 6 and 7 under 35 U.S.C. §112, second paragraph, as being indefinite, Applicant amended Claims 3, 6 and 7. Applicant respectfully submits that Claims 3, 6 and 7 particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, the Patent Office rejected Claim 3 as having insufficient antecedent basis for the term "the medical disorders." Claim 3 has been amended to define "medical conditions". Sufficient antecedent basis for "medical conditions" is found in Claim 1 which defines "providing a database on the remote server wherein the database stores information relating to a plurality of medical conditions." Claim 6 was rejected because it was unclear whether it is a medical resource or a computer that treats the medical condition. Claim 6 has been amended to "disclosing on one of the remote computers a practitioner that treats the medical condition queried". Claim 7 was rejected because it was unclear whether it is a medical resource or a computer that treats the medical condition. Applicant amended Claim 7 to define "disclosing to the individual remote computer the medical facility that treats the medical condition queried".

In view of the foregoing, Applicant submits that Claim 3, 6 and 7 now particularly point out and distinctly claim the subject matter

which Applicant regards as the invention. Accordingly, Applicant respectfully submits that the rejections under 35 U.S.C. §112, second paragraph, have been overcome in view of the amended claims. Notice to that effect is requested.

With respect to the rejection of Claims 1-11 and 13-20 under 35 U.S.C. §103(a) as being unpatentable over *Iliff* in view of *Schlueter et al.*, Applicant submits that the rejection has been overcome in view of the amended claims and for the reasons that follow.

The Patent Office alleges that *Iliff* teaches a method for matching medical condition information with a medical resource. The method, the Patent Office alleges, has the steps of:

providing a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website; accessing the website via an individual remote computer on the computer network; providing a database on the remote server wherein the database stores information relating to a plurality of medical conditions; and searching the database from the information wherein the search or request is based on the query or search request input into the database and further wherein the search discloses a medical resource that treats the medical condition queried.

However, the Patent Office admits that *Iliff* fails to explicitly disclose inputting a query into the website wherein the query relates to a medical condition. The Patent Office alleges

that *Schlüter et al.* teach inputting a query or request for data into the website wherein the query relates to a medical condition. The Patent Office states that it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify the method for matching medical condition information with a medical resource of *Iliff* to include inputting of a query into the website.

Claim 1 requires a method for matching medical condition information with a medical resource. The method has the steps of searching the database for information wherein the search is based on the query input into the database and wherein the search discloses a medical resource that treats the medical condition queried.

Claim 15 requires a system for matching medical condition information with a medical resource. The system has a means for querying the database wherein the query relates to one of the medical conditions and a means for searching the database for information wherein the information discloses a medical resource that treats the medical condition queried.

Iliff merely discloses a system for providing computerized medical diagnostic advice. The medical advice is provided to the general public over a network, such as a telephone network. The network provides medical advice and access to health care information.

Nowhere does *Iliff* teach or suggest searching a database for information wherein the search is based on a query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried as required by Claims 1 and 15. Further, *Iliff* does not disclose inputting a query into the website wherein the query relates to a medical condition as required by Claim 1. Moreover, *Iliff* does not teach or suggest searching a database for information wherein the search is based on the query input into the database as required by Claims 1 and 15.

Schlueter et al. teach a method and system that assists medical practitioners who treat or prescribe treatment of patients having a medical condition which requires long-term profiling of medical data taken from the patient's body. Practitioners take medical readings of predetermined medically important variables. The readings are stored as raw data in a data receptacle, such as a smart card, and then are input into a remote computer. The readings are then displayed for the practitioner when needed.

However, *Schlueter et al.* do not teach or suggest a method for matching medical condition information with a medical resource. *Schlueter et al.* do not teach or suggest a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website as required by Claims 1 and 15. Further, *Schlueter et al.* do not teach or suggest inputting a query into the website wherein the query relates to a medical condition as required by Claims 1 and 15. *Schlueter et al.* merely

retrieve and store patient data and history. Schlueter et al. do not search a database for information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried as required by Claims 1 and 15.

Applicant asserts that neither *Iliff* and/or *Schlueter et al.*, taken singly or in combination, disclose, teach, or suggest a search based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition as required by Claims 1 and 15. Additionally, neither *Iliff* nor *Schlueter et al.*, taken singly or in combination, teach a method for matching a medical condition with a medical resource.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.

Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Iliff* and *Schlueter et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have combined *Iliff* with *Schlueter et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103(a).

The Patent Office alleges that one skilled in the art would recognize that the method of *Iliff* for electronically reviewing and adjudicating medical insurance claims could be modified in light of *Schlueter et al.* to create a method and system for matching medical conditions information with a medical resource on a computer network. Applicant submits that the Patent Office is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Applicant's method and system

to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible.

Applicant respectfully submits that the claims distinctly defines the present invention from *Iliff* and *Schlueter et al.* taken singly or in combination. Applicant submits that, for the reasons provided above, the rejections of the Patent Office under 35 U.S.C. §103(a) have been overcome and should be withdrawn. Notice to that effect is requested.

In view of the foregoing remarks and amendments, Applicant respectfully submits that the rejection of Claims 1-11 and 13-20 under 35 U.S.C. §103(a) have been overcome and should be withdrawn. Notice to that effect is requested.

As to the rejection of Claim 12 under 35 U.S.C. §103(a) as being unpatentable over *Iliff* and *Schlueter et al.*, and further in view of *Siegrist, Jr. et al.*, Applicant respectfully submits that the rejection of Claim 12 is improper for the same reasons set forth with respect to Claim 1. Namely, *Iliff*, *Schlueter et al.* and *Siegrist, Jr. et al.* fail to teach or suggest the features defined in Claim 1 as set forth above. Notice to that effect is requested.

Claims 2-14 depend from Claim 1; and Claims 16-20 depend from Claim 15. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional steps and elements of Applicant's method and system, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are

in allowable form and that the application is in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

(Reg. No. 35,018)

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CERTIFICATE OF MAILING

I hereby certify that this **AMENDMENT** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D. C. 20231 on Jan 21, 2003.

Brian M. Mattson (Reg. No. 35,018)

VERSION WITH MARKS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Please amend the first full paragraph of page 9 as follows:

Figure 2 illustrates a method 50 for accessing a website and retrieving information from one of the databases 18, 20, as illustrated in Figure 1. The method 50 may include an access website step 52. An individual using one of the remote computers 24, 26, as shown in Figure 1, or any other remote computer connected with the computer network 22 may access one of the websites 14, 16 or any other website that may provide access to databases 18, 20 (shown in Figure 1), or any other database containing the information therein.

IN THE CLAIMS:

Please amend Claim 3 as follows:

3. The method of Claim 1 wherein the medical [disorders] conditions relate to diseases.

Please amend Claim 6 as follows:

6. The method of Claim 1 further comprising the step of: disclosing to one of the remote computers a practitioner [to one of the remote computers] that treats the medical condition queried.

Please amend Claim 7 as follows:

7. The method of Claim 1 further comprising the step of:

disclosing [a medical facility] to the individual remote computer a medical facility that treats the medical condition queried.